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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/936,460

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Hartwig Schwier

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05/06/2005

SCHIFF HARDIN, LLP
PATENT DEPARTMENT
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EXAMINER

MILIA, MARK R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,460

Applicant(s)

SCHWIER ET AL.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/13/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 2, reference character "19", Fig. 3, reference character "24", Fig. 7, reference character "43", and Fig.9, reference characters "60" and "61". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "56" has been used to designate both a "Spool File" in Fig.8 and an "EPE Print Processor" in Fig. 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of

the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: On page 16, third paragraph, last line, "33" should read "34" and page 20, second paragraph, second to last line, "43" should read "53". Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 43 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 43 is directed to a computer program. Such a claim is non-statutory because the terminology "computer program" alone has no set definition. A statutory product with descriptive material must include a positive recitation

of the computer readable medium, see MPEP 2106. Examiner suggests amending the claims to read "A computer program embodied in a computer readable medium for performing the steps of..." or "A computer readable medium storing a program for performing the steps of..." or any other similar wording which best clarifies the claim and includes a positive recitation of the computer readable medium.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 40 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5562351 to Uematsu.

Uematsu discloses a method for transmission of data from a computer system that to an output device, comprising the steps of: providing a master document having a variable data area and a static data area (see Figs. 1 and 4 and column 5 lines 10-16), marking the variable data area (see Fig. 1D and column 6 lines 17-22), inserting variable data into the variable data area, as a result whereof a serial data stream with individual documents arises (see Fig. 1 and column 6 lines 7-67), separating the variable data from the serial data stream from the static data on a basis of the marking (see Fig. 1 and column 6 lines 6-67), transmitting the variable data separated from the static data

from the first individual document to the output device (see Fig. 1A and column 6 lines 41-63), storing the static data of the first individual document in the output device (see Fig. 3 and column 5 lines 3-19), the static data of following individual documents are not transmitted to the output device (see Fig. 1 and column 9 lines 6-31), and joining the variable data in turn with the stored static data individual document by individual document in the output device (see Fig. 1 and 10 and column 9 lines 6-31).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-31, 33-39, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5983243 to Heiney et al. in view of U.S. Patent No. 5982996 to Snyders.

Regarding claims 22, 43, and 44, Heiney discloses a method and system for transmission of data from a computer system that is operated with a Windows or windows-like operating system to an output device, comprising the steps of: generating a master document (see Fig. 3 and column 4 lines 21-67), logically linking a plurality of auxiliary documents with the master document by forming reference indices (see Fig. 3 and column 5 lines 12-20 and 38-49), sending the data of the auxiliary documents to the

output device separated from data of the master document (see Fig. 3 and column 3 line 56-column 4 line 10), joining the data of the auxiliary documents with the data of the master document in the output device upon employment of the reference indices (see Fig. 3 and column 5 lines 57-61), generating a print job from an application program (see Fig. 3 and column 5 lines 63-64) including: calling a printer driver first (see column 3 lines 61-66, reference states that the raster image processor translates the PDL document into printable dot patterns which is analogous to the function of a printer driver), setting settings of the appertaining printer supported by the called printer driver job-specifically (see column 4 lines 4-10 and 39-41), and enabling the print job, as a result whereof the data of at least one of the master document and of the auxiliary documents are generated (see Fig. 3 and column 5 lines 63-64).

Heiney does not disclose expressly carrying out a check in a check step to see whether the respectively generated output format corresponds to a standard prescribed by the operating system, supplying the data, when there is correspondence, to a print processor located in a spooler and, when non-correspondence is found in the check step, are converted by an operating system-specific converter unit into an intermediate data stream that is further-processed via various output channels.

Snyders discloses carrying out a check in a check step to see whether the respectively generated output format corresponds to a standard prescribed by the operating system (see column 7 lines 42-45 and column 8 lines 4-9) and supplying the data, when there is correspondence, to a print processor located in a spooler and, when non-correspondence is found in the check step, are converted by an operating system-

specific converter unit into an intermediate data stream that is further-processed via various output channels (see column 6 line 60-column 7 line 15, column 7 lines 39-41, and column 8 lines 3-9, 14-35, and 51-54).

Heiney & Snyders are combinable because they are from the same field of endeavor, formatting document data for subsequent printing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the printer driver switching to allow distribution of print jobs to an output device of Snyders with the system of Heiney.

The suggestion/motivation for doing so would have been to allow a plurality of different types of printers to output the same document data that is created by a user at a personal computer or workstation regardless of the format of the data in which the printer is capable of handling.

Therefore, it would have been obvious to combine Snyders with Heiney to obtain the invention as specified in claims 22, 43, and 44.

Regarding claim 23, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses storing the data of the auxiliary documents in the output device (see column 3 line 66-column 4 line 10, reference shows the storage of documents being located in a print server that is attached to the printer).

Regarding claim 24, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses joining the data of the master document with the data

of the auxiliary documents for output of individual documents (see column 5 lines 52-65).

Regarding claim 25, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses attaching the auxiliary documents to at least one arbitrary regions of the first document at a beginning of the output (see column 5 lines 10-21).

Regarding claim 26, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses controlling the referencing in a windows systems environment or in a windows-like system environment via data that are input via a user interface (see Figs. 1 and 2, column 3 lines 25-43, and column 4 lines 21-34).

Regarding claim 27, Heiney and Snyders disclose the system discussed in claim 26, and Heiney further discloses whereby the referencing ensues in a converter unit that converts an enhanced metafile data stream into a print data stream of a printer language (see column 4 line 55-column 5 line 29).

Regarding claim 28, Heiney and Snyders disclose the system discussed in claim 27, and Snyders further discloses whereby the converter unit collaborates with a print processor and a port monitor of a spooler (see column 8 lines 59-67 and column 9 lines 18-27).

Regarding claim 29, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses specifying the area of the master document wherein a respective auxiliary document is linked with the master document (see column 5 lines 37-49).

Regarding claim 30, Heiney and Snyders disclose the system discussed in claim 29, and Heiney further discloses wherein said specifying step specifies a page region (see column 5 lines 37-49).

Regarding claim 31, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses indicating whether an auxiliary document is one of an overlay and a watermark document (see column 5 lines 37-49, reference states that a bookticket is created that instructs the collator how to merge the variable data with the fixed data form and one way in which that is accomplished is by overlaying the variable data onto the fixed data, the reference also states this in claim 14, therefore the reference teaches overlaying variable data).

Regarding claim 33, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses wherein said output device is a printer device (see Figs. 1 and 3, column 4 lines 1-10, and column 5 lines 63-64).

Regarding claim 34, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses transmitting an auxiliary document to the output device in the PCL print data language (see column 4 lines 37-39, reference states the use of a PostScript or other similar PDL, of which PCL is a part of).

Regarding claim 35, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses transmitting an auxiliary document to the output device in the Postscript print data language (see column 4 lines 37-39).

Regarding claim 36, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses transmitting an auxiliary document to the output device

Art Unit: 2622

in the IPDS print data language (see column 4 lines 37-39, reference states the use of a PostScript or other similar PDL, of which IPDS is a part of).

Regarding claim 37, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses transmitting an auxiliary document to the output device in the LCDS print data language (see column 4 lines 37-39, reference states the use of a PostScript or other similar PDL, of which LCDS is a part of).

Regarding claim 38, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses wherein an auxiliary document contains graphics information (see column 4 lines 39-41).

Regarding claim 39, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses 39. A method as claimed in claim 38, wherein said graphics information is one of an image datafile and a diagram (see column 4 lines 39-41).

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heiney and Snyders as applied to claim 22 above, and further in view of U.S. Patent No. 6473892 to Porter.

Heiney and Snyders do not disclose expressly wherein an auxiliary document is a macro datafile.

Porter discloses wherein an auxiliary document is a macro datafile (see Fig. 2 and column 8 line 46-column 9 line 13).

Heiney, Snyders, & Porter are combinable because they are from the same field of endeavor, formatting document data for subsequent printing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the macro datafile as described by Porter with the system of Heiney and Snyders.

The suggestion/motivation for doing so would have been to provide greater flexibility and create more options as a macro can contain a plurality of objects and properties that can be made of use in the merging of data.

Therefore, it would have been obvious to combine Porter with Heiney and Snyders to obtain the invention as specified in claim 32

Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uematsu in view of U.S. Patent No. 5649024 to Goldsmith.

Regarding claim 41, Uematsu does not disclose expressly wherein said marking step of the variable data region ensues by a visually perceptible identification.

Goldsmith discloses wherein said marking step of the variable data region ensues by a visually perceptible identification (see column 6 lines 51-57 and column 7 lines 24-35, 48-52, and 61-67, reference shows that text data may be merged with scanned in hardcopy documents at that certain fonts of the merge data may be color highlighted).

Regarding claim 42, Uematsu does not disclose expressly wherein said marking step of the variable data region ensues chromatically.

Goldsmith discloses wherein said marking step of the variable data region ensues chromatically (see column 6 lines 51-57 and column 7 lines 24-35, 48-52, and 61-67).

Uematsu & Goldsmith are combinable because they are from the same field of endeavor, merging and manipulation of document data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combining the color highlighting of originally black text as described by Goldsmith with the system of Uematsu.

The suggestion/motivation for doing so would have been to allow desired text to stand out in a document that has been created from merging text or graphic data with a master document.

Therefore, it would have been obvious to combine Goldsmith with Uematsu to obtain the invention as specified in claims 41 and 42.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to U.S. Patent numbers 6330073 (Sciatto), 5165014 (Vassar), 6078403 (Palmer), 5740338 (Gauthier et al.), 6236463 (Cyman et al.), 5845302 (Cyman, Jr. et al.), 5465322 (Hsu et al.), 5504843 (Catapano et al.), 5615316 (Imai et al.), 6320667 (Mitsubishi), and 6108672 and 6481752 (DeJoseph).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
Art Unit 2622

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JOSEPH R. POKRZYWA
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Joseph R. Pokrzywa